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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,793	01/23/2001	Tim Carruthers	109.635.128	2247

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HALE AND DORR, LLP  
60 STATE STREET  
BOSTON, MA 02109

EXAMINER
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YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/767,793

Applicant(s)

CARRUTHERS ET AL.

Examiner

John L Young

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*MLW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1067 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

*John Leonard Young*

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2, 4-5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-67 are rejected under 35 U.S.C. §103( a ) as being obvious over Dimitriadis et al. 5,664,948 (09/09/1997) (herein referred to as "Dimitriadis").

As per independent claim 1, Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; FIG. 7; FIG. 8; and whole document) shows: "A method of scheduling deliver of multiple items of content selectively to a plurality of online users, comprising: determining expected values relating to each user being online during a given time period; and generating an ordered list of the items of content to be selectively delivered to the users based on the expected values, said list being prioritized to meet delivery requirements associated with said items of content."

Dimitriadis lacks an explicit recitation of "online during a given time period. . . ." even though the cited disclosure of Dimitriadis implicitly shows same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis would have been selected in accordance with the elements and limitations of claim 1, because selection of such features would have provided means where "*the advertiser incurs less expense for each advertisement presentation. . . .*" (See Dimitriadis (col. 2, ll. 20-30)). Furthermore, the instant invention would have been rendered obvious in view of Dimitriadis, because the claims of the instant invention suffer from undue breadth.

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As per claims 2-23, Dimitriadis shows the method of claim 1 and subsequent base claims depending from claim 1.

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; FIG. 7; FIG. 8; and whole document) shows the elements and limitations of claims 2-23.

Dimitriadis lacks an explicit recitation of the elements and limitations of claims 2-23 even though the disclosure of Dimitriadis implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Dimitriadis would have been selected in accordance with the elements and limitations of claims 2-23, because selection of such features would have provided means where *“the advertiser incurs less expense for each advertisement presentation. . . .”* (See Dimitriadis (col. 2, ll. 20-30)).

As per independent claim 24, Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; FIG. 7; FIG. 8; and whole document) shows the elements and limitations of claim 24.

Dimitriadis lacks an explicit recitation of the “Web users” and “determining probability. . . .” elements of claim 24 , even though the cited disclosure of Dimitriadis implicitly shows same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis would have been selected in accordance with the elements and limitations of claim 24, because selection of such features would

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have provided means where *“the advertiser incurs less expense for each advertisement presentation. . . .”* (See Dimitriadis (col. 2, ll. 20-30)).

As per claims 25-37, Dimitriadis shows the method of claim 24 and subsequent base claims depending from claim 24.

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; FIG. 7; FIG. 8; and whole document) shows the elements and limitations of claims 25-37.

Dimitriadis lacks an explicit recitation of the elements and limitations of claims 25-37 even though the disclosure of Dimitriadis implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Dimitriadis would have been selected in accordance with the elements and limitations of claims 25-37, because selection of such features would have provided means where *“the advertiser incurs less expense for each advertisement presentation. . . .”* (See Dimitriadis (col. 2, ll. 20-30)).

Independent claim 38 is rejected for substantially the same reasons as independent claim 1.

Independent claim 39 is rejected for substantially the same reasons as independent claim 1.

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As per dependent claims 40-41, Dimitriadis shows the system of claim 39.

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; FIG. 7; FIG. 8; and whole document) shows the elements and limitations of claims 40-41.

Dimitriadis lacks an explicit recitation of the elements and limitations of claims 40-41 even though the disclosure of Dimitriadis implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Dimitriadis would have been selected in accordance with the elements and limitations of claims 40-41, because selection of such features would have provided means where *"the advertiser incurs less expense for each advertisement presentation. . ."* (See Dimitriadis (col. 2, ll. 20-30)).

Independent claim 42 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 43-55, Dimitriadis shows the method of claim 42.

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; FIG. 7; FIG. 8; and whole document) shows the elements and limitations of claims 43-55.

Dimitriadis lacks an explicit recitation of the elements and limitations of claims 43-55 even though the disclosure of Dimitriadis implicitly shows same.

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It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Dimitriadis would have been selected in accordance with the elements and limitations of claims 43-55, because selection of such features would have provided means where *“the advertiser incurs less expense for each advertisement presentation. . .”* (See Dimitriadis (col. 2, ll. 20-30)).

Independent claim 56 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 57-59, Dimitriadis shows the method of claim 56.

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; FIG. 7; FIG. 8; and whole document) shows the elements and limitations of claims 57-59.

Dimitriadis lacks an explicit recitation of the elements and limitations of claims 57-59 even though the disclosure of Dimitriadis implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Dimitriadis would have been selected in accordance with the elements and limitations of claims 57-59, because selection of such features would have provided means where *“the advertiser incurs less expense for each advertisement presentation. . .”* (See Dimitriadis (col. 2, ll. 20-30)).

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Independent claim 60 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 61-67, Dimitriadis shows the method of claim 60.

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; FIG. 7; FIG. 8; and whole document) shows the elements and limitations of claims 61-67.

Dimitriadis lacks an explicit recitation of the elements and limitations of claims 61-67 even though the disclosure of Dimitriadis implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Dimitriadis would have been selected in accordance with the elements and limitations of claims 61-67, because selection of such features would have provided means where *"the advertiser incurs less expense for each advertisement presentation. . ."* (See Dimitriadis (col. 2, ll. 20-30)).

### CONCLUSION

3. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

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Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or (703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

May 3, 2004